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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,114	09/21/2001	Kenneth B. Higgins	5113B	5752

7590 10/07/2005
Milliken & Company
P.O. Box 1927
Spartanburg, SC 29304

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,114

Applicant(s)

HIGGINS ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 88, 90, 92-123, 125-128, 131 and 149 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 88, 90, 92-123, 125-128, 131, and 149 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment filed August 9, 2005 has been entered. Claims 88, 90, 93-95, 97-99, 101, 102, 105-109, 111-113, 115, 118, 120, 131, and 149 have been amended accordingly. Claims 1-87, 89, 91, 124, 129, 130, and 132-148 are cancelled. Thus, the pending claims are 88, 90, 92-123, 125-128, 131, and 149.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 88, 90, 92-123, 125-128, 131, and 149 stand rejected under 35 USC 103(a) as being unpatentable over US 4,552,857 issued to Higgins in view of US 5,610,207 issued to DeSimone et al. for the reasons of record.

Response to Arguments

5. Applicant's amendments to the claims merely limit the compressible particles bonded together to being foam particles. Since the previous rejections have been addressed the particles as foam particles (i.e., rebond foam), said amendment is insufficient to overcome the prior art rejection.
6. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. Applicant traverses the rejections by asserting that DeSimone is not directed to attached cushion carpet, but rather to a foam pad for carpeting (Amendment, paragraph spanning pages 8-9). The examiner respectfully disagrees. Specifically, DeSimone teaches a rebond polyurethane foam product which is suited for a carpet backing (abstract and col. 2, lines 34-45). DeSimone employs the term "carpet backing" rather than carpet pad, underlay, or other common term used to describe a non-attached foam layer for placement under an installed carpet. As such, the examiner believes the DeSimone reference clearly teaches one skilled in the art that the rebond foam is suited for attachment as a carpet backing layer.
7. Applicant also states, "As described earlier and as agreed to by the Examiner, it would not have been obvious to substitute rebond foam for the virgin foam in a carpet tile." (Amendment, page 9, 1st paragraph). It appears applicant is confusing the examiner's words since the rejection of record is based upon the obviousness of substituting a rebond foam layer as taught by DeSimone for the foam layer of Higgins '857. [Note Non-Final Office Action mailed May 13, 2004, page 4, 1st paragraph].
8. Applicant traverses the rejection based upon the previously submitted 132 Declaration and the accepted wisdom in the art (Amendment, page 10, 2nd paragraph – page 12, 1st

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paragraph). While said arguments and declaration establish the accepted wisdom in the art that rebond foam would not be suited for successful carpet tiles due to the lack of uniformity in thickness and density which produces a reduced strength and durability, applicant has failed to show unexpected results achieved. Specifically, the Kilpatrick Declaration states, "It was surprising and unexpected that rebond foam would work as well as virgin polyurethane foam in a carpet tile." (Declaration, page 2, section 21). However, said declaration does not quantitatively describe said unexpected results. Additionally, it has not been shown that the present carpet tiles having the same construction as the Milliken Comfort Plus[®] cushion back carpet tiles with the exception of the rebond foam layer. In other words, applicant has not clearly established the two carpet tiles having identical constructions other than the foam cushion backing (i.e., rebond vs. virgin polyurethane) have similar performance characteristics. It is well settled that unexpected results must be established by factual evidence. "Mere argument or conclusory statements in the specification does not suffice." *In re De Blauwe*, 222 USPQ 191. It is this equivalent performance that is unexpected in view of the accepted wisdom in the art that rebond foam is inferior to virgin foam in strength, durability, uniformity, etc.

9. MPEP 2145 states that proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. In particular, *In re Hedges*, 228 USPQ 685 held that the "PTO acted erroneously in determining that claimed process for sulfonating diphenol sulfone at its molten state would be obvious from prior art, *since* references all suggest that lower temperatures are preferable, and *none suggests that reaction may be advantageously produced at molten state*, and *since data produced by inventor*, and not challenged by PTO, *show significant advantages of claimed invention*, so that, on balance, inventor proceeded contrary to accepted wisdom, which is

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strong evidence of unobviousness.” [Emphasis added.] Additionally, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, states “On the entire record and in view of all the references, each in its entirety, it is clear that a person of ordinary skill confronted with a PTFE tape breakage problem would have either slowed the rate of stretching or increased the temperature to decrease the crystallinity. Dr. Gore did neither. He proceeded contrary to the accepted wisdom of the prior art by dramatically increasing the rate and length of stretch *and* retaining crystallinity. That fact is strong evidence of nonobviousness.”

10. The differences between the *Hedges* and *Gore* situations and the present invention are (1) the present prior art of record (i.e., DeSimone) explicitly teaches rebond foam employed as a carpet backing and (2) both the *Hedges* and *Gore* cases showed advantageous results were achieved when proceeding contrary to the accepted wisdom. Proceeding contrary to the accepted wisdom in the art is not sufficient to show nonobviousness—especially when the prior art has an explicit teaching thereto. However, the successful results achieved *are what is contrary* to the accepted wisdom. One skilled in the art would expect rebond foam to produce a commercially unsuccessful carpet tile due to the lack of uniformity in thickness and density. This is the accepted wisdom in the art. But, *proceeding contrary* to the accepted wisdom *to achieve advantageous or unexpected results* is evidence of nonobviousness. Thus, applicant is requested to provide sufficient evidence of said advantageous results.

11. It is recommended that applicant submit a signed declaration describing in detail the construction of each carpet tile (e.g., face yarn composition and denier, face weight, thickness, and density, primary backing construction and weight, pre-coat layer composition and weight, hot melt composition and weight, reinforcement layer construction and weight, foam cushion

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back composition, weight, thickness, and density, and backing layer construction and weight).

Said declaration should also include the results of performance tests that reflect the cushion layer of the carpet tile (e.g., cushion resilience, Herzog walking comfort rating, castor chair test, Gmax, etc.). It is noted that the scope of said declaration would establish the scope of allowable subject matter. For example, if the two carpet tiles are equivalent in all aspects except the foam composition (i.e., thickness and density of foam are alike), then the allowable subject matter would be a carpet tile having a rebond foam backing. However, say the two carpet tiles differ with respect to the foam layer composition and average foam density, then the scope of the allowable subject matter would be a carpet tile having the rebond foam layer and a specified foam density.

12. Also note that the examiner is not necessarily requesting applicant conduct a new series of comparative performance tests, but rather is merely asking for clarification of data presented in specifications of related applications. For example, application 09/910,085 states Standard Milliken ComfortPlus® cushion-backed carpet tile has a Gmax test value of 116, while a rebond cushion backed carpet tile of the present invention has a Gmax value of 121 (application 09/910,085, page 88). However, the exact constructions of both carpet samples with respect to materials, weights, thicknesses, densities, etc. are not given. Hence, it is not clear if the unexpected equivalent performances are due to the rebond foam layer and not any other factor (e.g., reinforcing layer, hot melt adhesive, foam density, etc.) alone or in combination with the rebond foam.

13. With the present amendment, applicant submits “a sample of a commercial carpet tile representative of copying by others” (Amendment, page 12, 2nd paragraph). Said sample is “a

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rebond foam backed carpet tile made and sold in 2004 in Europe by a competitor of Milliken & Company' (Amendment, page 12, 2nd paragraph). "Applicants respectfully believe this to be sufficient evidence of copying by others which is one of the nonobviousness and patentability factors to be considered." (Amendment, page 12, 2nd paragraph). The examiner respectfully disagrees. First, the sample is not labeled or documented in any way as to the carpet construction and source thereof. Said sample is merely labeled with the present application number. Secondly, without details of the construction of said carpet sample, the examiner cannot possibly verify it as "copying" of the present invention. The Patent Office does not have the capability for analysis of samples. Thirdly, with respect to applicant's evidence of copying, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors (see MPEP 716.06). Alleged copying is not persuasive of nonobviousness when the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766. Therefore, applicant's submission of a sample of "copying" is not found persuasive and the above rejection is maintained.

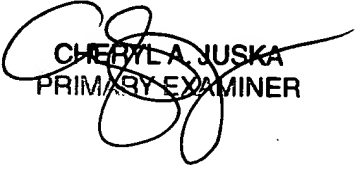
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached

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at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
October 1, 2005